

REMARKS

This application has been reviewed in light of the Office Action dated October 6, 2005 and the Advisory Action dated March 2, 2006. Claims 1 and 4-18 are presented for examination. Claim 1 has been amended to define more clearly what Applicants regard as their invention. In addition, Claims 1 and 10 have been amended to correct a typographical error (relating to the position of the phrase “forming a hydroelastic spring”). Claims 1 and 10 are in independent form. Favorable reconsideration is requested.

Applicants note with appreciation the allowance of Claims 10-13 and the withdrawal of the rejections of Claims 11 and 12 under 35 U.S.C. § 112, second paragraph.

Claims 1, 4, 5 and 15-18 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,273,406 (“Miyamoto”) in view of U.S. Patent No. 6,899,323 (“Takeshita”). Claims 6-9 stand rejected as obvious over Miyamoto in view of Takeshita and U.S. Patent No. 5,516,083 (“Sprang”). Claim 14 stands rejected as obvious over Miyamoto in view of Takeshita and U.S. Patent No. 6,622,996 (“Mayerbock”).

Miyamoto and Takeshita both relate to bulge-type bushings. In Miyamoto, the bulge is formed by a spherical portion (11₂) on the support shaft (11) (see Fig. 1 and col. 4, lines 1-15). In Takeshita, the bulge is formed by a bulge-shaped annular cover of synthetic resin (20) disposed around the inner cylinder (10) (see Fig. 1 and col. 4, lines 8-10). Figures 7 and 8 of Takeshita, on which the Examiner relies, also relate to bulge-type bushings. The bulge portion in these designs is formed by a bulge-shaped annular cover (112) that is secured in the axial direction by annular recesses in the surface of the inner cylinder (110)(see Figs. 7 and 8 and col. 1, line 53 - col. 2, line 30).

All of the structures disclosed in Miyamoto and Takeshita have an elastic element that conforms to a bulge in a central portion of the inner cylinder. Thus, the combination of Miyamoto and Takeshita does not teach or suggest an “elastically deformable element adhering on a central portion with a constant cross-section of said internal reinforcement,” as recited in Claim 1. Nor do the cited references teach or suggest “said first and second elastically deformable elements adhering on a central portion with a constant cross-section of said intermediate reinforcement,” as further recited in Claim 1.

The Examiner states that one of ordinary skill in the art would have been motivated to replace Miyamoto’s inner cylinder with a cylinder having a constant cross-section, as purportedly taught by Takeshita. However, nothing in Takeshita teaches or suggests using an inner cylinder without the associated bulge-shaped annular cover. To the contrary, Takeshita highlights the benefits of a bushing with a bulge:

In a so-called bulge type of vibration-isolating bushing wherein an annular cover made of a synthetic resin is provided as a bulge portion on an outer periphery of an axially central part of an inner cylinder, such a vibration-isolating bushing that is superior in buckling strength in the axial direction of the inner cylinder, low-cost, and advantageous in environmental aspect, while preventing any displacement of the annular cover is provided.

(Abstract). Thus, even if one would have been motivated to combine Miyamoto and Takeshita, the result would be a bulge-type bushing having an inner cylinder with an annular cover forming the bulge portion.

Regarding the hypothesized combination of Miyamoto and Takeshita, the Examiner asserts that “[t]his design improves riding comfort over the reinforcement having a central bulge portion.” (Office Action at page 3). However, the Examiner has not

provided any support for this statement, and Applicants believe that it is entirely speculative. Applicants therefore respectfully traverse this assertion and, to the extent that the Examiner is relying on common knowledge in the art or on a scientific theory, request that the Examiner cite a reference in support of this position, in accordance with M.P.E.P. §§ 2144.02 and 2144.03.

Finally, Applicants note that the Examiner has not provided any support for a reasonable expectation of success in combining Takeshita's inner cylinder, without its associated annular member, into Miyamoto's bushing.

The prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success.

MPEP 2143.02 (citing *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.

M.P.E.P. § 2143 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)) (emphasis added).

For at least these reasons, it is respectfully submitted that Claim 1 is patentable over the combination of Miyamoto and Takeshita.

A review of the other art of record, including Sprang, Mayerbock, and Hadano (U.S. Patent No. 5,887,859), has failed to reveal anything which, in Applicants' opinion, would remedy the deficiencies of the art discussed above, as references against Claim 1. Claim 1 is therefore believed patentable over the art of record.

The remaining rejected claims depend from Claim 1 and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,


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